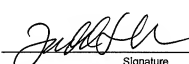


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 020375-043700US	
I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office MAIL STOP: AF on <u>March 30, 2009.</u> TOWNSEND and TOWNSEND and CREW LLP By: <u> /Tara N. Damhoff/ </u> Tara N. Damhoff		Application Number 10/694,924	Filed October 27, 2003
		First Named Inventor Justin Monk	
		Art Unit 3693	Examiner Paul W. Shumate
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>54,544</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u> </u></p> </div> <div style="width: 45%; text-align: center;">  _____ Signature <u>Tadd F. Wilson</u> _____ Typed or printed name <u>303-571-4000</u> _____ Telephone number <u>3/30/09</u> _____ Date </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<input type="checkbox"/> *Total of <u> </u> form is submitted.			

TOWNSEND and TOWNSEND and CREW LLP

By: /Tara N. Damhoff/
Tara N. Damhoff

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Justin Monk

Application No.: 10/694,924

Filed: October 27, 2003

For: METHODS AND SYSTEMS FOR
MANAGING INTEGRATED
CREDIT AND STORED VALUE
PROGRAMS

Customer No.: 20350

Confirmation No.: 5090

Examiner: Paul W. Shumate

Art Unit: 3693

PRE-APPEAL BRIEF
REQUEST FOR REVIEW

MAIL STOP: AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejections dated December 31, 2008 (the "Office Action") for the above-identified application. A response after-final has been filed in this application, but no amendments were made in that response, and none have been entered after-final. An Advisory Action was later issued on the above-identified application on February 23, 2009 (the "Advisory Action"). No amendments to the claims are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated herein.

REMARKS/ARGUMENTS

Reasons for Appeal:

There are two reasons for this appeal:

1. Whether the combination of Teicher, Armetta, Hirka, Todd, and Simpson fails to teach all the claim limitations; and
2. Whether Hirka's requirement for additional information beyond an account number teaches away from the combination.

I. Whether the combination of Teicher, Armetta, Hirka, Todd, and Simpson fails to teach all the claim limitations

Claims 1-9 and 20-25 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,076,075 to Teicher ("Teicher") in view of U.S. Patent No. 5,864,830 to Armetta et al. ("Armetta"), and further in view of U.S. Patent Application Publication No. 2003/0061157 A1 to Hirka et al. ("Hirka"). Claims 1-4, 6-9 and 20-25 have also been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0061093 A1 to Todd ("Todd") in view of U.S. Patent No. 6,070,153 to Simpson ("Simpson"), and further in view of Hirka. The cited combination of references fails to describe the following limitation: "wherein the instrument includes a single identifier such that a merchant is able to access funds from both the credit account and the stored value account with the single identifier."

The Examiner has relied on Hirka to describe this limitation of the claims. However, the Examiner's argument is based on a misreading of the description. Hirka does describe a single card "encoded with credit card account, bank account, and stored value account information." *Hirka*, ¶ [0008]. Thus, Hirka describes a physical card encoded with a credit card number, a bank account number, and a stored value account number. Indeed, this information is encoded "on the card in manner that is machine readable in systems that read credit cards, in a systems that reads bank cards, and in at least one system that reads stored value card." *Id.* Each different account number can be read by a different type of machine. To determine which account to use, the "routing of card transactions [is] based on additional information." *Id.* A

consumer must instruct or the information in the transaction must identify which account number to read and route in the transaction.

The Examiner, in the advisory action, cites several other portions of *Hirka* and purports that the embodiments disclosed teach a single identifier for multiple accounts. However, the Examiner's argument is based on misreading *Hirka*. *Hirka* never teaches anything different than multiple account numbers for multiple accounts. First, *Hirka* specifically states that the "card issuer is able to route transactions through a chain of processors based on an appropriate type of account based on transaction data." *Hirka*, ¶ [0021]. Thus, the type of transaction controls which account information will be read from the physical card. *See id.* The physical card still stores multiple account identifiers; an account identifier is stored for each type of transaction, e.g., credit card transaction or ATM transaction. Only one of the multiple account identifiers is read and used.

The other embodiment does not include a single account identifier that identifies multiple accounts. Rather, *Hirka* describes that the "alias account information is sufficient to identify the card issuing institution and within the institution the customer." *Hirka*, ¶ [0023]. Thus, the account identifier identifies a customer and the card issuer but not the account. *Hirka* states that the card issuer "makes authorization decisions and debits the correct actual account based on receiving a PIN that corresponds to one of the customer's multiple accounts." *Id.* Thus, each account is identified by one of several PINs that are provided by the consumer. These embodiments are very different than the claims.

The differences between the cited art and the present claims are simple but profound. *Hirka* and the other references describe a system where a physical card stored several account numbers. One of the account numbers is read at the point-of-sale. The single account number selected and read from the physical card is used to route the transaction to the account identified by the account number. The claims describe a single account number stored on card or other payment instrument. The single identifier can be used to access two or more accounts. Thus, a merchant has the ability to select which account to use without needing more than one account number. Due to this difference, the systems function very differently. The present claims can require an account selection after reading the single account number. *Hirka* requires a selection of one account before reading one of the account numbers. Or, *Hirka* requires reading

all the account numbers then selection from one of those account numbers. Due to these structural and processing differences, the claims are different from and allowable over the cited art.

2. Whether Hirka's requirement for additional information beyond an account number teaches away from the combination


"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." M.P.E.P. § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)). Beyond the fact that the card described in Hirka includes different account identifiers for the different accounts, Hirka specifically teaches against the combination made by the Examiner. Hirka states that "routing of card transactions [is] based on additional information beyond the single account number." *Hirka*, ¶ [0008]. Hirka teaches that more information is needed beyond the single identifier. For example, Hirka requires the type of transaction accepted by the merchant, e.g., credit card, ATM account, etc. Thus, Hirka teaches away from a single identifier used to access multiple accounts. The Examiner's motivation for the combination is thus improper and the claims are allowable over the cited art for at least this reason.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending are allowable over the cited art. Applicant respectfully requests that the rejections be withdrawn. As such, the claims are in condition for allowance and an action to that end is respectfully requested.

Respectfully submitted,

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